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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,791	02/25/2002	Mark Madison Engleman		7982

7590  
Mark Engleman  
607 East Reserve Street  
Vancouver, WA 98661

03/21/2006

EXAMINER

BOYCE, ANDRE D

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/084,791

Applicant(s)

ENGLEMAN ET AL.

Examiner

Andre Boyce

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-3 have been examined.

#### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because: The specification to which the oath or declaration is directed has not been adequately identified. Applicant's identification of application 60/271,508 is not sufficient because that is not the nonprovisional application number. See MPEP § 602.

#### ***Priority***

3. The Examiner acknowledges Applicant's priority to provisional application number 60/271,508 filed February 23, 2001, however the provisional application is not recognized as being a priority application for this current nonprovisional application (10/084791), in the USPTO system. Appropriate correction is requested.

#### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "115" in Figure 2.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The abstract of the disclosure is objected to because reference character "110" is not in the specification or the drawings. Correction is required. See MPEP § 608.01(b).
6. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code, as seen, at least on page 3 of the specification, lines 2, 4, 6, and 12. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

***Claim Objections***

7. Claim 1 is objected to because of the following informalities: The claim is missing an --and-- between the two limitations of the claim. Appropriate correction is required.
8. Claim 2 is objected to because of the following informalities: The claim is missing an --and-- between the last two limitations of the claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
10. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said business software profile and methods" in line 6 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 is rejected based upon the same rationale, since it depends therefrom.

Claim 2 is rendered vague and indefinite for use of the verbiage "computer system," because it is unclear what Applicant defines as a computer system (i.e., processor, other hardware, software, combination, etc.).

Claim 3 recites the limitation "said method for managing business software" in lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "said computer processors" in line 12. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 is also rendered vague and indefinite for use of the phrase "similar data on other business under said method for managing business software." It is unclear what is meant by "similar data" and "other business." Further, it is unclear what steps comprise "under said method for managing business software."

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis et al (The Information System Consultant's Handbook, December 1998).

As per claim 1, Davis et al disclose a method for planning and executing a business software planning and management process applicable to a company or organization (i.e., analysis and design of information systems, including software, §1.4.1, pages 5 and Figure 1.3), the method comprising the steps of: Profiling the said company's business software requirements (i.e., problem definition, wherein the problems are identified, cause determined, and strategy outlined for solving problems, §1.4.4, page 7) to generate a list of prioritized actions and issues applicable to improving the said company's said business software (i.e., system

analysis in order to determine exactly what must be done to solve the problem, § 1.4.4, page 7), and Using said business software profile and methods, effecting improvement actions for said business, including improving existing business software, selecting and implementing new business software (i.e., system development, wherein solutions are implemented, § 1.4.4, page 8).

As per claim 2, Davis et al disclose at least one of the steps are implemented on a computer system (i.e., processes are converted to computer programs, § 1.4.4, page 7).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (The Information System Consultant's Handbook, December 1998), in view of Abu El Ata (USPN 6,311,144).

As per claim 3, Davis et al disclose a computer-based method for analyzing a business entity to devise and maintain a business software management plan applicable to the said business entity (i.e., analysis and design of information systems, including software, wherein processes are converted to computer programs (§1.4.1, pages 5, Figure 1.3, § 1.4.4, page 7), the method comprising the

steps of: Conducting a business software profiling of said business entity (i.e., problem definition, wherein the problems are identified, cause determined, and strategy outlined for solving problems, §1.4.4, page 7), said profiling comprising the said business entity's actions and issues applicable to improving the said business entity's said business software (i.e., system analysis in order to determine exactly what must be done to solve the problem, § 1.4.4, page 7). Davis et al does not disclose Storing said profiling in a storage device of a data processing system; Outputting said profiling, to a second computer to compare said business entity's said business software profile to similar data on other business under said method for managing business software; Storing said profile to said second computer; and Determining, based upon said stored profiling and said computer processors, what business software improvement actions are appropriate for the said business entity. Abu El Ata discloses descriptive data that describes the information system of an organization, stored in an input module (columns 3-4, lines 64-66 and 1-3), which passes on the information to a construction module, wherein the data is processed to construct an initial model of the proposed information system (column 4, lines 53-58). Further, Abu El Ata discloses redesigning an existing information system, including an initial model of the information system, additional models or scenarios, and an implemented information system (column 17, lines 50-56), wherein additional models may be constructed, stored, and compared based upon performance and a preferred model selected, including new or changed software components from the component library (column 18, lines 59-67). Both Davis et al and Abu El Ata are



concerned with effective information system development, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include Storing said profiling in a storage device of a data processing system; comparing said business entity's said business software profile to similar data on other business under said method for managing business software; and Determining, based upon said stored profiling and said computer processors, what business software improvement actions are appropriate in Davis et al, as seen in Abu El Ata, as an effective means of determining what software components are needed for the redesigned system, making Davis et al more flexible in determining needed component and system modifications.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Vellante et al (US 2002/0069102) disclose assessing and quantifying the business value of an information technology.

-Bidgoli (Handbook of Management Information Systems) discloses tools and techniques for building information systems.

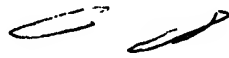
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571) 272-6726. The examiner can normally be reached on 9:30-6pm M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

adb  
March 18, 2006

  
ANDRE BOYCE  
PATENT EXAMINER  
A.U. 3623